

Subject: Questions and comments on proposed rules

I have a question and contingent comments about the attached proposed rule change involving 35 USC 41(a)(1)(G) and 37 CFR 1.52 (f)(1), which I have excerpted.

Initially, I am puzzled regarding what it is meant to encompass. The subject matter relates to the filing of a patent application in an electronic medium with specific exclusions for sequence listings and computer programs as well as submissions with the Office electronic filing system. As far as I am aware, this leaves only tables which are in excess of 50 pages which can be submitted on electronic medium. Is this rule change restricted to such submission? If so I have no further comment except to note that the application of the rule should have been spelled out more explicitly.

If the rule somehow has broader applicability to the actual filing of patent applications then it manifestly has discriminatory effect based on subject matter of the patent application. Chemical patent applications and, in particular, pharmaceutical patent applications, of necessity, have an extensive number of embedded chemical structures. As a result, for such applications, the carefully calculated correlation of 2000 bytes to a single page results in a very harsh monetary penalty. As an example, an actual typical case which we filed had a total of 68 paper pages but an electronic size of about 640k bytes. According, to the proposed rule if filed in electronic medium this application would have a content size of 320 pages with a monetary filing penalty (large entity) of \$1250 for a case well under the 100 page size limit. The USPTO has not taken into account the electronic size of images such as ChemDraw structures, PDF tables and the like, which have significantly higher byte totals when compared to the ASCII text used for the calculations. Along these lines, I would also query the treatment of drawings per se which count in the application page total but which also take up considerably more than 2000 bytes per page.

This aspect of the proposed rules should therefore be clarified and, if applicable as I have outlined, recalculated.

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Attached Proposed Rule Change:

The Office is also implementing the provision in 35 U.S.C. 41(a)(1)(G) for the Office to prescribe the paper size equivalent of an application filed in whole or in part in an electronic medium for purposes of the application size fee specified in 35 U.S.C.

41(a)(1)(G) (Sec. 1.16(s) and Sec. 1.492(j)). A 21.6 cm by 27.9 cm (8 1/2 by 11 inches) sheet of paper with a top margin of 2.0 cm (3/4 inch), a left side margin of 2.5 cm (1 inch), a right side margin of 2.0 cm (3/4 inch), and a bottom margin of 2.0 cm (3/4 inch), will contain about 30 lines of double-spaced text, with each line having about 50 to 65 characters. An ASCII text (the only format permitted by Sec. 1.52(e)) document containing 30 lines of text, each line having about 50 to 65

characters, will be slightly less than two kilobytes in size.

Therefore, the Office is proposing that each two kilobytes of content submitted on an electronic medium shall be counted as a sheet of paper for purposes of the application size fee specified in 35 U.S.C.

41(a)(1)(G) (Sec. 1.16(s) and Sec. 1.492(j)).

Sec. 1.52 Language, paper, writing, margins, compact disc specifications.

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(f) (1) Any sequence listing in an electronic medium in compliance with Sec. Sec. 1.52(e) and 1.821(c) or (e), and any computer program listing filed in an electronic medium in compliance with Sec. Sec. 1.52(e) and 1.96, will be excluded when determining the application size fee required by Sec. 1.16(s) or Sec. 1.492(j). For purposes of determining the application size fee required by Sec. 1.16(s) or Sec. 1.492(j), for an application the specification and drawings of which, excluding any sequence listing in compliance with Sec. 1.821(c) or (e), and any computer program listing filed in an electronic medium in compliance with Sec. Sec. 1.52(e) and 1.96, are submitted in whole or in part on an electronic medium other than the Office electronic filing system, each two kilobytes of content submitted on an electronic medium shall be counted as a sheet of paper.